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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

P1364

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on 03/10/2006

Signature *Patricia Lambuth*

Typed or printed name Patricia Lambuth

Application Number

10/016,831

Filed

12/12/2001

First Named Inventor

Mark Andrew Boys

Art Unit

3621

Examiner

Calvin L. Hewitt II

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

/Donald R. Boys/

Signature

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Date

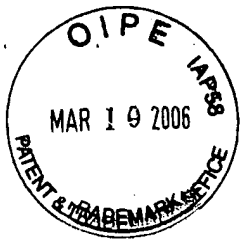
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit: 3621

Examiner: Hewitt II, Calvin L.

In Re: Mark Andrew Boys
Case: P1364
Serial No.: 10/016,831
Filed: 12/12/2001
Subject: A Direct Passthrough System for Financial Contributions

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

**Reasons Supporting Request for a
Pre-Appeal Conference**

A Notice of Appeal and a petition for a pre-appeal conference is filed herewith in the above-referenced case, and the instant paper presents the applicants' reasons for requesting a pre-appeal conference; specifically that the applicant does not believe the Examiner has provided a prima-facie rejection in the case, and the time and expense to both parties for a formal appeal are clearly unnecessary..

To better illustrate the applicants' belief, the broadest independent claim that will be appealed in the case is reproduced below in its last-amended form:

1. *(Previously presented) A system for managing donations comprising:*

an Internet-connected server accessible by donors using an Internet browser;
a data store accessible to the server and storing information about individuals or families, pre-qualified for donations and associated each with a specific account with a financial institution, the account enabling the potential donors to make contributions and the pre-qualified individuals or families to withdraw donated funds; and
software executing on the server, enabling the donors to obtain specific information about the pre-qualified individuals or families, and also enabling the donors to select one or more of the pre-qualified individuals or families and to make donations to the specific accounts associated with the selected pre-qualified individuals or families.

In the action appealed, mailed 02/09/2006 and made Final, the Examiner has maintained all of the rejections and reasoning of the previous action as follows:

1. Claims 1-12 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

The Examiner states that the claim language: "...a data store accessible to the server and storing information about individuals or families, pre-qualified for donations and associated each with a specified account with a financial institution..." is unclear, as it is

unclear what the applicant means by "associated each".

The applicant contends that the language is perfectly clear to the person with ordinary skill in the art, and grammatically correct. Each individual or family is associated with a specific account with a financial institution. That is, there is a bank account in the name of the person or family. The applicant contends that the language of "...a person being associated with a specific account with a financial institution..." would be difficult to misconstrue by a person with ordinary skill in the art.

2. Claims 1-7 and 13-19 stand rejected under 35 U.S.C. 103(a) over Gruber et al., US publication 2002/0029179, hereinafter Gruber, and claims 8-12 and 20-24 under 35 U.S.C. 103(a) over Gruber in view of Cohen, US Patent 6,422,462.

The Examiner contends that the limiting language of claim 1 "... a data store accessible to the server and storing information about individuals or families, pre-qualified for donations and associated each with a specific account with a financial institution, the account enabling the potential donors to make contributions and the pre-qualified individuals or families to withdraw donated funds..." does not distinguish over the reference Gruber or other intermediary, such as the American Red Cross. The Examiner makes this point in his reasons for rejection, and has made the same point in a telephone interview with the applicant's representative, signed below.

In applicant's claimed system individual families or persons, pre-qualified for direct donations, are presentable to a potential donor. The individual or family is associated with a bank account to which the potential donor may donate money, and from which the qualified person or family may withdraw the donated funds. The ownership of the money donated never resides in an intermediary, such as Gruber or the American Red Cross.

The donor may provide funds directly to the individual or family, and a qualified person may withdraw the funds without permission from any intermediary.

The Examiner's contention that the limitation in claim 1 to a pre-qualified individual or family associated with an account at a financial institution to which a donor may contribute and from which the individual or family may withdraw funds, does not distinguish over an organization like the American Red Cross that collects money from donors, keeps the money in accounts controlled by the organization, and exercises complete control over who may get money and when and how, is very hard to understand.

The distinguishing difference is clearly in who is in control of the money. In the prior art, and in all of the art cited by the Examiner, there is no direct donation that may be accessed by a pre-qualified individual or family. The Examiner's contention that the recipients must withdraw the money, because they need it, is a bit of a stretch.

The Examiner deals with the software limitations of applicant's amended claim 1: *"software executing on the server, enabling the donors to obtain specific information about the pre-qualified individuals or families, and also enabling the donors to select one or more of the pre-qualified individuals or families and to make donations to the specific accounts associated with the selected pre-qualified individuals or families"*, by stating that "these tasks are never actually performed and the software merely enables the task to occur or potentially occur ("to be", "may be" or "enable" language). To one of ordinary skill, a server is a computer, and a computer utilizes software such as an operating system, that *enables* the server to be *programmed* to perform numerous tasks (e.g. search databases, pay for goods and services, send email and play music online). Hence, the server of Gruber et al. necessarily comprises Applicant's *enabling* software."

The Examiner ignores that clear fact that in the recited claim the programming is a fact, and stated as a limitation, not an intention. It is notoriously settled practice in the USPTO that a computer enhanced with software that performs a specific function is a new machine, and that functional limitation of computerized machines is correctly done by such recitation. The Examiner's contention that this language merely indicates that

"programming might be done" is unarguably in error. The language of the claim limits the invention to a system that actually performs these functions.

Clearly Gruber does not teach specifically the limitations of applicant's claim 1, and the limitations cannot be inferred by Gruber. Claim 1 is therefore clearly patentable over Gruber, and claims 2-12 are patentable on their merits or at least as depended from a patentable claim.

As to claims 13-24 the primary reference Gruber is so woefully inadequate that these claims are patentable by the same arguments presented above on behalf of claims 1-12.

As all of the claims standing for examination have been clearly demonstrated to be patentable as amended over the art of record, applicant respectfully requests reconsideration, and that the present case be passed quickly to issue. If there are any time extensions needed beyond any extension specifically requested with this response, such extension of time is hereby requested. If there are any fees due beyond any fees paid with this amendment, authorization is given to deduct such fees from deposit account 50-0534.

Respectfully Submitted,
Mark Andrew Boys

By /Donald R. Boys/
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